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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,770	01/11/2004	Markus Hildinger	MP3	1769

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EXAMINER	
AHMED, AFFAF	
ART UNIT	PAPER NUMBER
3622	
MAIL DATE	DELIVERY MODE
06/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/707,770	HILDINGER ET AL.	
	Examiner	Art Unit	
	AFAF AHMED	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 05/14/2008.

2. Claims 1-36 have been amended.

3. Claims 1-46 are currently pending and have been examined.

Response to Applicant's Arguments

4. With regard to claims 1-36 objection, Applicant has amended claims1-36, therefore the objection is withdrawn.

5. With regard to claims 1 and 2, Applicant's amendment has clarified claim rejections - 35 USC § 112 second paragraph. Therefore, the claim rejection is withdrawn.

6. With regard to claims 1 and 2, Applicant arguments are considered, but they are moot based on the new ground of rejection.

Claim Objections

7. Claims 37-45 are objected to because of the following informalities: Claims 37-45 are objected to under 37 CFR 1.75 (c) as being in improper form because a multiple dependent claim should refer to others claims in the alternative only, and/or can not depend from any other multiple dependent claim. See MPEP § 608.01 (n). Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-7,10,13-16, 20, 24-27,33,36-39 and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Frerichs et al, US Pat No: 6,684,249 B.

As per **claims 1 and 24**, Frerichs teaches:

- *selling and/or distributing a digital audio file wherein said digital audio file comprises (a) an advertisement message part in a digital audio format, and (b) a music entertainment part in a digital audio format* (see at least column 3, lines 66-67 and column 4, lines 1-57);

As per **claims 2 and 25,** Frerichs teaches:

- *wherein said advertisement message part (a) directly precedes the music entertainment part, and/or (b) directly follows the music entertainment part, and/or (c) is located within (interrupts) the music entertainment part, and/or (d) is overlaid (superimposed) on the music entertainment part, and/or (e) overlaps with the music entertainment part* (see at least column 2, lines (24-30 and 40-52));

As per **claims 3 and 26,** Frerichs teaches:

- *wherein the advertisement message part and the music entertainment part are integrated into the digital audio file so that both parts are reproduced or played together on a decoding or playback device once a decoding or playback is initialized by a user, hardware, or software* (see at least column 4, lines 18-42);

As per **claims 4-7, 10,13, 27-30,33 and 36**, Frerichs teaches:

- *wherein said digital audio file (advertisement part, music part) refers to a file format (same compressed file format) selected from at least one of the following file formats: MPEG-2.AAC (Advanced Audio Coding), ATRAC3 (Adaptive Transform Acoustic Coding 3), MP3 (MPEG-1. Audio Layer 3), mp3PRO, MS audio (WMA: Windows Media Audio), TwinVQ (Transform-Domain Weighted Interleave Vector Quantization), Q design, RealAudio, AMR-NB, MP4, MIDI, WAV, or any other digital format or electronic music distribution (EMD) system* (see at least column 9, lines 12-26);

As per **claims 14 and 37**, Frerichs teaches:

- *wherein said digital audio file is sold, distributed, acquired, accessed, downloaded, delivered, transferred, transmitted and/or received via (a) the Internet (including downloading; e-mail; wired; wireless via WiFi, 802.11a/b/g, 802.16); and/or (b) wireless phone networks based on transmission standards like GSM 900/1800/1900, GPRS, E-GPRS, EDGE, HSCSD, CSD, CDMA, UMTS and 3G networks; and/or (c) wireless transmission (Bluetooth 1.0; Bluetooth 2.0; Infrared; WiFi; 802.11a/b/g; 802.16); and/or (d) local (computer) stations that might be located in or outside of*

stores (e.g., music retail stores); and/or (e) storage devices including CDs, DVDs, Memory Cards, Memory Sticks, Secure Digital (SD) cards, Multimedia (MMC) cards, Compact Flash cards, Smart Media cards, USB Flash Disks, Microdrives; and/or (f) radio, terrestric, cable or satellite transmission (see at least column 3, lines 24-54);

As per **claims 15, 16, 38 and 39**, Frerichs teaches:

- *wherein said advertisement message part advertises, mentions, and/or refers to (a) physical products including food, drugs, beverages, cars, tobacco, cosmetics; and/or (b) services such as banking, financial services, travel, leisure activities, phone service, wireless service, cable service; and/or (c) companies, brands, institutions, corporations, (legal) entities; and/or (d) entertainment content such as movies, television content, music; and/or (e) events such as sporting events, cultural events; and/or (f) persons, artists, groups, or individuals; and/or (g) a general message (such as referral to a web site where a specific product can be acquired); and/or (h) advice; and/or any combination within and/or between the different groups;*
- *wherein said advertisement message part comprises (a) music; and/or (b) sound; and/or (c) noise; and/or (d) spoken words; and/or (e) a jingle or music branding; and/or (f) voice branding; and/or any combination within and/or between the different groups;*

See at least column 2, lines 30-36;

As per **claims 20 and 43**, Frerichs teaches:

- *wherein said digital audio file is played-back or reproduced on a computer, decoding device, (portable) MP3 player, (portable) digital music player, (portable) digital audio player, cellular phone, smart phone* (see at least column 3, lines 24-31);

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 8-9, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frerichs et al, US Pat No: 6,684,249 B in view of Ramachandran, US Pat No 6457640..

Claims 8, 9, 31 and 32:

Frerichs discloses the limitations as shown above.

Frerichs further discloses:

- *wherein said advertisement message part (compressed file* (see at least column 2, lines 37-39);

Frerichs does not specifically disclose, but Ramachandran, however, discloses:

- *said music entertainment part are in different digital audio formats;*
- *wherein the digital audio file is in an uncompressed digital audio format;*

See at least column 1, lines 44-65;

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Frerichs's teaching of method and system of adding advertisements over streaming audio based over the internet with Ramachandran's teaching of dispensing of digital information with the motivation of distributing audio digital recording of sounds using a variety of recording sound formats.

13. Claims 11, 23, 34 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frerichs et al, US Pat No: 6,684,249 B1 in view of Jung Pub No: 2003/0014310.

Claims 11 and 34:

Frerichs discloses the limitations as shown above.

Frerichs does not specifically disclose, but Jung, however, discloses:

- *wherein said digital audio file comprising an advertisement message part and a music entertainment part is sold at a lower price than a digital audio file comprising said same music entertainment part, but no advertisement message part* (See at least paragraph 59);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Frerichs's teaching of method and system of adding advertisements over streaming audio based over the internet with Jung's teaching of method of providing multimedia files combined with advertisements over the internet with the motivation to entice consumers to listen to the advertisement and download music at lower cost.

Claims 23 and 46:

Frerichs discloses the limitations as shown above.

Frerichs does not specifically disclose, but Jung, however, discloses:

- *wherein the consumer pays a specific price each time the consumer plays a digital audio file* (see at least paragraph 37);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Frerichs's teaching of method and system of adding advertisements over streaming audio based over the internet with Jung's teaching of method of providing multimedia files combined with advertisements over the internet with the motivation to entice consumers to listen to the advertisement and download music at lower cost.

14. Claims 12, 21-22, 35, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frerichs et al, US Pat No: 6,684,249 B1 in view of Strietzel US, Pat No: 6950804.

Claims 12 and 35:

Frerichs discloses the limitations as shown above.

Frerichs does not specifically disclose, but Strietzel however discloses:

- *wherein playback of said advertisement message part does not take more than preferentially 15%, more preferentially 10% and most preferentially 5% of the time it takes to playback said music entertainment part* (see at least column 10, lines 3-13);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Frerichs's teaching of method and system of adding advertisements over streaming audio based on user profile over the internet with Strietzel's teaching of system and methods for distributing targeted multimedia content and advertising with the motivation of providing advertisers with customized advertisement spot (s) to broadcast their commercial messages effectively.

15. Claims 17, 18, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frerichs et al, US Pat No: 6,684,249 B1 in view of Deguchi, US Pub No: 2002/0010652 A1.

Claims 17, 18, 40 and 41:

Frerichs discloses the limitations as shown above.

Frerichs does not specifically disclose, but Deguchi however, discloses:

- *wherein said music entertainment part is a digital audio format of a single or a digital audio format of a part of a single that is or was listed on the Billboard Hot 100 single charts or Top 40 tracks;*
- *wherein said music entertainment part is a digital audio format of at least one past, present or future single independent of the way it is published;*

See at least paragraphs 57, 59 and 61;

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Frerichs's teaching of method and system of adding advertisements over streaming audio based over the internet with Deguchi's teaching of tracking music marker device with the motivation of providing consumers with continuously updated list of the top hit singles.

16. Claims 19 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frerichs et al, US Pat No: 6,684,249 B1 in view of Robins, US Pat No 6,728,167 B1.

Claims 19 and 42:

Frerichs discloses the limitations as shown above.

Frerichs does not specifically disclose, but Robins however discloses:

- *wherein the content and/or position of said advertisement message part can change from playback to playback of the digital audio file* (see at least column 7, lines 18-37);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Frerichs's teaching of method and system of adding advertisements over streaming audio based on user profile over the internet with Robins's teaching of system and methods of background music controller with the motivation of relieving the boredom of having the same sequence of advertisement (s) and/or music played to users.

Claims 21-22 and 44-45:

Frerichs discloses the limitations as shown above.

Frerichs does not specifically disclose, but Strietzel however discloses:

- *wherein the consumer acquires the right to play a specific digital audio file for an unlimited number of times by paying a specific price at one point in time;*
- *wherein the consumer acquires the right to play one or more digital audio files for an unlimited number of times by paying a subscription fee;*

See at least column 8, lines 35-48 and column 9, lines 8-22,

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Frerichs's teaching of method and system of adding advertisements over streaming audio based on user profile over the internet with Strietzel's teaching of system and methods for distributing targeted multimedia content and advertising with the motivation of providing consumers with flexibility in determining how to pay for songs and/or a content.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is files within TWO MONTHS from the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX Months from the mailing date of this final.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

/Yehdega Retta/
Primary Examiner, Art Unit 3622